

Appl. No. : 09/927,851
Filed : August 10, 2001

REMARKS

Claims 1-25 and 32-39 were pending in this application. The Examiner rejected Claims 1-25 and 32-39. By this amendment, Applicant has amended Claims 1, 19, and 32-35, and canceled Claims 36-39. As a result, Claims 1-25 and 32-35 are now pending. Reconsideration of the application, as amended, is respectfully requested.

Rejections under 35 U.S.C. § 112

The Examiner has rejected Claims 1-25 and 32-39 under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. Specifically, the Examiner has cited MPEP 2173.05(d), and alleged that the phrase “description of the physical” renders the claims indefinite because it is unclear whether the limitation or limitations following the phrase are part of the claimed invention. (7/12/04 Office Action, page 2.)

Applicant respectfully traverses the rejection. The Examiner has failed to provide any reason or explanation as to why it would not be clear to one of ordinary skill in the art that the limitations following the phrase are part of the claimed invention. Further, MPEP 2173.05(d) is directed to a discussion of whether exemplary claim language may be indefinite, and does not appear to apply to the claim language at issue.

Claim 1 recites, “[a] method of organizing and sharing Internet links, electronic files and hardcopy documents, the method comprising,” *inter alia*, “enabling the user to enter comments about a hardcopy document; storing the entered comments about the hardcopy document and a description of the physical location of the hardcopy document in a hardcopy document record in the database.” (Emphasis added.) The above underlined language is clear on its face, and as explained in the specification and figures, simply refers to the description of the location of the hardcopy document. The specification even goes so far as to provide examples of such a “description of the physical location,” such as the “living room,” or a “top shelf.” (See specification, page 8, lines 6-10, and Figure 6.) Furthermore, from the above cited language of claim 1, it is clear that storing a description of the physical location of the hardcopy document in a hardcopy document record in the database is a part of the claimed method. Thus, Applicant asserts that the claims would be clear and definite to one of ordinary skill in the art, and requests that the rejection be withdrawn.

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If the Examiner continues to maintain the rejection in view of the above arguments, Applicant requests that the Examiner clarify on the record why he feels it would not be clear to one of ordinary skill in the art that the limitations at issue would be part of the claimed invention, and explain the relevance of MPEP 2173.05(d).

The Examiner has also rejected Claims 1-25 and 32-39 under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. Specifically, the Examiner has asserted that the phrase “description of the physical” is not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor, at the time the application was filed, had possession of the claimed invention. (7/12/04 Office Action, page 3.)

As discussed above, however, the specification and figures, as originally filed, describe and provide examples of the phrase “description of the physical location,” (see specification, page 8, lines 6-10, and Figure 6), thus demonstrating that the inventor had possession of the claimed invention at the time the application was filed. Thus, Applicant asserts that the claims satisfy the written description requirement, and requests that the rejection be withdrawn.

Allowable Subject Matter

The Examiner objected to Claims 36 and 38 as being dependent upon a rejected base claim, but stated that the claims would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims. (7/12/04 Office Action, page 9.) Accordingly, Applicant has amended Claims 1 and 19 to incorporate the limitations originally recited in Claims 36 and 38, respectively. In addition, Applicant has amended Claims 32-35 to incorporate the same limitations.

As a result, Claims 1-25 and 32-35 all incorporate the allowable subject matter identified by the Examiner, and Applicant respectfully requests allowance of these claims.

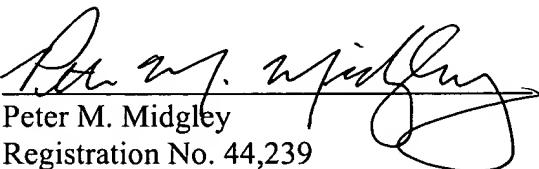
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CONCLUSION

In view of the foregoing amendments and remarks, Applicant respectfully submits that Claims 1-25 and 32-35 are in condition for allowance and notification to that effect is earnestly requested. If the Examiner has any remaining questions or concerns regarding the application, Applicant respectfully requests that the Examiner contact the undersigned at (208) 433-1231 to arrange a telephonic interview with the Examiner and his supervisor or Primary Examiner before any further action is taken.

Respectfully submitted,

Dated: 10/12/04

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